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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,896	06/27/2003	Jason Cahill	MSFT-2154/302766.1	7211
41505 7590 06/18/2007 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER DADA, BEEMNET W	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/607,896	CAHILL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Beemnet W. Dada	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

Art Unit: 2135

### DETAILED ACTION

1. This office action is in reply to an amendment filed on April 04, 2007. Claims 1, 7, 13 and 19 have been amended. Claims 1-24 are pending.

### *Response to Arguments*

2. Applicant's arguments filed April 04, 2007 have been fully considered but they are not persuasive. Applicant argues that the art on record fails to teach obtaining a license being performed in an automatic manner without first receiving an explicit request to obtain a license. Examiner disagrees.

3. Regarding the issue of amendments to independent claims 1, 7, 13 and 19, where the claims were amended to include the phrase "obtaining being performed in an automatic manner without first receiving an explicit request to obtain the license", the examiner cites MPEP 2173.05(i)

*"Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff 'dmem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."*

4. The phrase clearly recites a negative limitation. Indeed, the specification must contain a full, clear and concise description of the claimed subject matter. The specification does not

Art Unit: 2135

literally or implicitly exclude obtaining being performed in an automatic manner without first receiving an explicit request to obtain the license. Examiner would further point out that the art on record Peinado (WO 00/59150) teaches obtaining the license for the protected content of the email from an RM server while still connectively coupled to the network and in response to receiving the email and recognizing the protected content therein, such obtaining being performed in an automatic manner without first receiving an explicit request to obtain the license, whereby the license is available to the recipient even when such recipient is not connectively coupled to the RM server by way of the network at a later time [page 32, line 6 - page 33, line 10], as indicated below. Examiner would also point out that, providing a mechanical or **automatic means to replace manual activity** which has accomplished the same result is a matter of design choice and involves only routine skill in the art, and therefore does not distinguish an invention from a prior art [*In re Venner*, 120 USPQ 192]. Examiner would point out that the art on record teaches the claim limitations and therefore the rejection is respectfully maintained.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach a right management system,

Art Unit: 2135

including obtaining a license being performed in an automatic manner without first receiving an explicit request to obtain the license.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Peinado et al. WO 00/59150 (hereinafter Peinado) [submitted with IDS filed on 10/14/03].

9. With respect to claims 1, 7, 13 and 19, Peinado teaches a method for a recipient to receive an email having rights management (RM) protected content therein, the protected content being encrypted and decryptable according to a content key (KD), the content key (KD) being found in a corresponding license, the method comprising:

receiving the email while connectively coupled to a network through which the email may be obtained [page 14, line 24-page 15, line 3, and page 21, lines 15-20];

recognizing that the received email has the protected content therein [page 21, lines 15-page 22, lines 8]; and

obtaining the license for the protected content of the email from an RM server while still connectively coupled to the network and in response to receiving the email and recognizing the protected content therein, such obtaining being performed in an automatic manner without first receiving an explicit request to obtain the license, whereby the license is available to the

Art Unit: 2135

recipient even when such recipient is not connectively coupled to the RM server by way of the network at a later time [page 32, line 6 - page 33, line 10].

10. As per claims 2, 8, 14 and 20, Peinado further teaches the method wherein such obtaining is performed in a manner transparent to the recipient of the email [page 32, line 6 – page 33, line 10].

11. As per claims 3-6, 9-12, 15-18 and 21-24, Peinado further teaches the method wherein obtaining the license comprises: placing a representation of the received email with the protected content therein into a queue, retrieving the representation of the received email from the queue, and requesting the license for the protected content of the retrieved email from the RM server [page 32, line 6 – page 33, line 10].

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2135

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

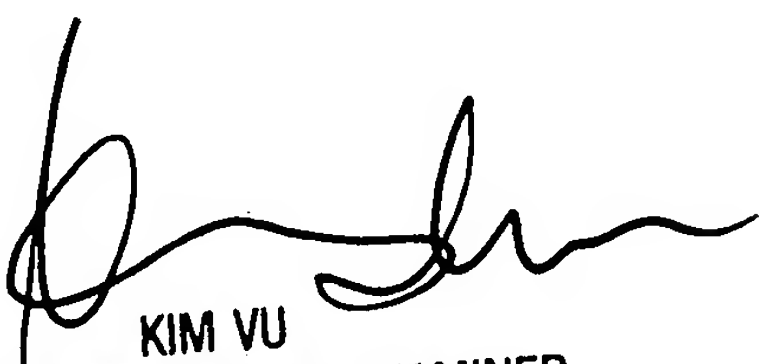
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Beemnet W Dada

June 8, 2007



KIM VU  
SUPERVISORY PATENT EXAMINER  
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